UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/295,690	04/21/1999	JEROME A MOUTON JR.	081862.P122	7482

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BLAKELY SOKOLOFF TAYLOR & ZAFMAN LLP
12400 WILSHIRE BOULEVARD SEVENTH FLOOR
LOS ANGELES, CA 90025

EXAMINER
FLEURANTIN, JEAN B

ART UNIT	PAPER NUMBER
2162	

DATE MAILED: 09/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *16 June 2005*.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-17* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-17* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

Response to Amendment

1.   This is in response to Applicant(s) arguments filed on 16 June 2005. Claims 1-17 remain pending

for examination.

Response to Applicant' Remarks

2.   Applicant's arguments filed 24 January 2005 have been fully considered but they are not

persuasive for the following reasons, see sections A and B.

Claim Rejections - 35 USC § 112

A.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter
> which the applicant regards as his invention.

i)   Claims 1, 9 and 13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for

failing to particularly point out and distinctly claim the subject matter which applicant regards as the

invention.

Claim 1 recites the limitation "a method comprising" in claim. There is insufficient antecedent

basis for this limitation in the claim.

Claim 9 recites the limitation "an apparatus for updating a message from a first version to an

upgraded version by chaining through intermediate versions comprising" in claim. There is insufficient

antecedent basis for this limitation in the claim.

Claim 12 recites the limitation "an apparatus comprising" in claim. There is insufficient antecedent

basis for this limitation in the claim.

Claim Rejections - 35 USC § 101

ii)   35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 1, 9 and 12 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

MPEP 2106 IV.B.2.(b)

A claim that requires one or more acts to be performed defines a process. However, not all processes are statutory under 35 U.S.C. 101. Schrader, 22 F.3d at 296, 30 USPQ2.d at 1460. To be statutory, a claimed computer-related process must either: (A) result in a physical transformation outside the computer for which a practical application in the technological arts is either disclosed in the specification or would have been known to a skilled artisan, or (B) be limited to a practical application within the technological arts.

Claims 1, 9 and 12, in view of the above cited MPEP section, are not statutory because they merely recite a number of computing steps without producing any tangible result and/or being limited to a practical application within the technological arts. The use of a computer has not been indicated.

Claim Rejections - 35 USC § 103

iii)   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 5-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat. No. 6,148,329 issued to Meyer ("hereinafter 'Meyer") in view of US Pat. No. 5,586,304 issued to Stupek, Jr. et al. ("hereinafter Stupek").

As per claim 5, Meyer discloses "an article if manufacturing comprising a computer readable

medium having instructions stored thereon" as relates to the content and format of the messages stored

in the folder and message database, which when executed by a data processing system causes the data-

processing system to perform a method, comprising (see col. 4, lines 29-31):

"receiving receipt of an update message having a first version format" as a means for redelivering

the stored message is to update the format of the message to the current format (see col. 2, lines 45-47);

further, in column 3, lines 4-11, Meyer discloses retrieving a first message from the mailbox or folder

ordered by version number, in which determining whether redelivery is a being specifically requested or

forced by the mail administrator if redelivery is being forced setting the message version to a number

which is different from a current version. Meyer does not explicitly disclose generating repeatedly

generation of a revised update message having a next most recent version format based on the update

message until a final update message having an upgraded version format is generated. However, Stupek

discloses a method for use in upgrading a resource of a computer from an existing version of the

resource to a later version of the resource (see col. 1, lines 56 to col. 2, line 41). Further, in column 9,

line 1 to column 10, line 6, Stupek discloses the upgrade installer builds the selected upgrade packages

and installation instructions into a job, which is transferred into a staging area, an agent client is then

notifies that a job has been placed in the staging area and the agent installs the packages in the job

according to the installation instructions. It would have been obvious to a person of ordinary in the art at

time the invention was made to modify the combined teachings of Meyer and Stupek with generating

repeatedly generation of a revised update message having a next most recent version format based on

the update message until a final update message having an upgraded version format is generated. Such

modification would allow the teachings of Meyer to improve the accuracy of the method and apparatus for

upgrading a database in a redundant environment by release chaining, and to provide automatically

determined the availability of upgrades to resources on a computer system (see col. 2, lines 42-44).

As per claim 6, in addition to claim 1, Meyer further discloses "calling of a next most recent version mapping function to map contents of the first update message to generate a second update message" (see col. 3, lines 6-14).

As per claim 7, Meyer discloses "wherein the update message includes a set of records for a database in the first version" (see col. 2, lines 60-64).

As per claims 8, Meyer discloses, "wherein the set of records for the database in the first version is a complete set of records for the database" as a means for existing messages will preferably be converted to the new format, the need for the conversion is automatically recognized by the message store (see col. 6, lines 52-54).

iv)   Claims 1-4 and 9-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat. No. 6,148,329 issued to Meyer ("hereinafter 'Meyer'") in view of US Pat. No. 5,586,304 issued to Stupek, Jr. et al. ("hereinafter Stupek") as applied to claims 5-8 above, and further in view of US Pat. 6,148,329 issued to Meyer ("hereinafter Meyer").

As per claim 1, Meyer discloses a method, wherein update comprises:

"receiving an update message having a first version format" as a means for redelivering the stored message is to update the format of the message to the current format (see col. 2, lines 45-47); further, in column 3, lines 4-11, Meyer discloses retrieving a first message from the mailbox or folder ordered by version number, in which determining whether redelivery is a being specifically requested or forced by the mail administrator if redelivery is being forced setting the message version to a number which is different from a current version. Meyer does not explicitly disclose repeatedly generating a revised update message having a next most recent version format based on the update message until a final update message having an upgraded version format is generated. However, Stupek discloses a method for use in upgrading a resource of a computer from an existing version of the resource to a later

version of the resource (see col. 1, lines 56 to col. 2, line 41). Further, in column 9, line 1 to column 10, line 6, Stupek discloses the upgrade installer builds the selected upgrade packages and installation instructions into a job, which is transferred into a staging area, an agent client is then notifies that a job has been placed in the staging area and the agent installs the packages in the job according to the installation instructions. It would have been obvious to a person of ordinary in the art at time the invention was made to modify the combined teachings of Meyer and Stupek with repeatedly generating a revised update message having a next most recent version format based on the update message until a final update message having an upgraded version format is generated. Such modification would allow the teachings of Meyer to improve the accuracy of the method and apparatus for upgrading a database in a redundant environment by release chaining, and to provide automatically determined the availability of upgrades to resources on a computer system (see col. 2, lines 42-44). While, Meyer and Stupek disclose the claimed subject matter except the claimed updating a message from a first version to an upgraded version by chaining through intermediate versions. However, Moser discloses an intermediate program P' that contains an intermediate version of each of the program modules to be upgraded, the intermediate version of a program module contains both the old version used in P and the new version used in P' (see Moser col. 3, lines 9-21). It would have been obvious to a person of ordinary in the art at time the invention was made to modify the combined teachings of Meyer, Stupek and Moser with updating a message from a first version to an upgraded version by chaining through intermediate versions. Such modification would allow the teachings of Meyer, Stupek and Moser to provide a mechanism that can upgrade a computer program without requiring that the normal operation of the computer program be suspended (see Moser col. 3, lines 32-36).

As per claims 2, 10 and 15, in addition to claim 1, Meyer further discloses "calling a next most recent version mapping function to map contents of the first update message to generate a second update message" (see col. 3, lines 6-14).

As per claims 3, 11 and 16, Meyer discloses "wherein the update message includes a set of records for a database in the first version" (see col. 2, lines 60-64).

As per claims 4, 12 and 17, Meyer discloses "wherein the set of records for the database in the first version is a complete set of records for the database" as a means for existing messages will preferably be converted to the new format, the need for the conversion is automatically recognized by the message store (see col. 6, lines 52-54).

As per claim 9, Meyer discloses "an apparatus comprising:
"means for receiving an update message having a first version format" as a means for redelivering the stored message is to update the format of the message to the current format (see col. 2, lines 45-47); further, in column 3, lines 4-1 1, Meyer discloses retrieving a first message from the mailbox or folder ordered by version number, in which determining whether redelivery is a being specifically requested or forced by the mail administrator if redelivery is being forced setting the message version to a number which is different from a current version. Meyer does not explicitly disclose a means for repeatedly generating a revised update message having a next most recent version format based on the update message until a final update message having an upgraded version format is generated. However, Stupek discloses a method for use in upgrading a resource of a computer from an existing version of the resource to a later version of the resource (see col. 1, lines 56 to col. 2, line 41). Further, in column 9, line 1 to column 10, line 6, Stupek discloses the upgrade installer builds the selected upgrade packages and installation instructions into a job, which is transferred into a staging area, an agent client is then notifies that a job has been placed in the staging area and the agent installs the packages in the job according to the installation instructions. It would have been obvious to a person of ordinary in the art at time the invention was made to modify the combined teachings of Meyer and Stupek with means for repeatedly generating a revised update message having a next most recent version format based on the update message until a final update message having an upgraded version format is generated. Such a modification would allow the teachings of Meyer to improve the accuracy of the method and apparatus for

upgrading a database in a redundant environment by release chaining, and to provide automatically determined the availability of upgrades to resources on a computer system (see col. 2, lines 42-44). While, Meyer and Stupek disclose the claimed subject matter except the claimed updating a message from a first version to an upgraded version by chaining through intermediate versions. However, Moser discloses an intermediate program P' that contains an intermediate version of each of the program modules to be upgraded, the intermediate version of a program module contains both the old version used in P and the new version used in P' (see Moser col. 3, lines 9-21). It would have been obvious to a person of ordinary in the art at time the invention was made to modify the combined teachings of Meyer, Stupek and Moser with updating a message from a first version to an upgraded version by chaining through intermediate versions. Such a modification would allow the teachings of Meyer, Stupek and Moser to provide a mechanism that can upgrade a computer program without requiring that the normal operation of the computer program be suspended (see Moser col. 3, lines 32-36).

As per claim 13, Meyer discloses an apparatus comprising:

"a network switching device to receive an update a message from a first version format" as a means for redelivering the stored message is to update the format of the message to the current format (see col. 2, lines 45-47); further, in column 3, lines 4-11, Meyer discloses retrieving a first message from the mailbox or folder ordered by version number, in which determining whether redelivery is a being specifically requested or forced by the mail administrator if redelivery is being forced setting the message version to a number which is different from a current version; and

"a controller card to update a message from a first version to an upgraded version by chaining through intermediate versions" as a means for determining whether a stored message is formatted in accordance with a current message (see col. 2, lines 40-47). Meyer does not explicitly disclose the controller card repeatedly generating a revised update message having a next most recent version format based on the update message until a final update message having an upgraded version format is generated. However, Stupek discloses a method for use in upgrading a resource of a computer from an existing version of the resource to a later version of the resource (see col. 1, lines 56 to col. 2, line 41).

Further, in column 9, line 1 to column 10, line 6, Stupek discloses the upgrade installer builds the selected upgrade packages and installation instructions into a job, which is transferred into a staging area, an agent client is then notifies that a job has been placed in the staging area and the agent installs the packages in the job according to the installation instructions. It would have been obvious to a person of ordinary in the art at time the invention was made to modify the combined teachings of Meyer and Stupek with repeatedly generating a revised update message having a next most recent version format based on the update message until a final update message having an upgraded version format is generated. Such a modification would allow the teachings of Meyer to improve the accuracy of the method and apparatus for upgrading a database in a redundant environment by release chaining, and to provide automatically determined the availability of upgrades to resources on a computer system (see col. 2, lines 42-44).

As per claim 14, Meyer discloses "wherein the network switching device receives a first update message" as previously received messages in the database need to be updated to reflect the new and existing attribute definitions, message delivery addresses this need by providing a mechanism whereby the message store deletes the previously captured message attribute information and recreates it as if the messages were just being delivered for the first time (see figure 1, col. 4, lines 42-49).

B.   In response to applicant's argument that "Applicants respectfully submit that the rejection is Applicants submit that the preamble 'A method comprising" is not a limitation. A 'method' is statutory subject matter within the boundaries set forth in 35 USC 101 which permits patents to be granted for 'any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof.' The term process, as defined in 35 USC 100 means process, art or method, and includes a new use of a known process, machine, manufacture, composition of matter, or material (MPEP 706.03(a)) (emphasis added). The word 'comprising' is a transitional phrase. In a method claim, the transition 'comprising' indicates that the claim is open ended and allows for additional steps (MPEP 2111.03, citing Invitrogen Corp. Biocrest Mfg., L.P., 327 F.3d 1364, 1368, 66 USPQ2d 1631, 1634 (Fed. Cir. 2003). Applicants further submit that the preamble phrase 'A method' is the proper form for an

independent method claim, such as claim 1. Claim 1 does not rely on a prior claim, and therefore requires no antecedent basis. Accordingly, applicants respectfully request that the rejection of claim 1 be withdrawn." It is submitted that claims 1, 9 and 12, in view of the above cited MPEP section, are not statutory because they merely recite a number of computing steps without producing any tangible result and/or being limited to a practical application within the technological arts. The use of a computer has not been indicated.

Further, a process that consists solely of the manipulation of an abstract idea is not concrete or tangible. See In re Warmerdam, 33 F.3d 1354, 1360, 31 USPQ2d 1754, 1759 (Fed. Cir. 1994). See also Schrader, 22 F.3d at 295, 30 USPQ2d at 1459.

Claim 1 represents an abstract idea that does not provide a practical application in the technological arts. There is no manipulation of data nor is there any transformation of data from one state to another state. Actually, no post-computer process activity is found in the technological arts. "a method comprising". Thus, no physical transformation is performed, no practical application is found. Also, the claims do not appear to correspond to a specific machine or manufacture disclosed within the specification and thus encompass any product of the class configured in any manner to perform the underlying process. Consequently, the claims are analyzed based upon the underlying process, and are thus rejected as being directed.

Applicant(s) is (are) advised to amend the claim(s) by specifying the claim(s) being directed to a practical applications and produce a tangible result being **executed by a general purpose computer (to be executed by a computer)** in order to correct the above indicated deficiencies.

Applicant(s) stated, page 11, that "The Office Action concedes that the combined teachings of Meyer and Stupek fail to teach or suggest the subject limitation, and seeks to invoke the motivation of one of ordinary skill in the art to modify the combined teachings of Meyer and Stupek. It is submitted that one of ordinary skill in the art would not be motivated to make such a modification. The examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it

takes into account only knowledge which was within the level of ordinary skill at the time the claimed

invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such

a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In response to applicant's argument, pages 13 and 14, that "the combination of Meyer, Stupek

and Moser fail to teach or suggest the subject limitation", the examiner recognizes that obviousness can

only be established by combining or modifying the teachings of the prior art to produce the claimed

invention where there is some teaching, suggestion, or motivation to do so found either in the references

themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837

F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir.

1992). In this case, While, Meyer and Stupek disclose the claimed subject matter except the claimed

updating a message from a first version to an upgraded version by chaining through intermediate

versions. However, Moser discloses an intermediate program P' that contains an intermediate version of

each of the program modules to be upgraded, the intermediate version of a program module contains

both the old version used in P and the new version used in P' (see Moser col. 3, lines 9-21). It would

have been obvious to a person of ordinary in the art at time the invention was made to modify the

combined teachings of Meyer, Stupek and Moser with updating a message from a first version to an

upgraded version by chaining through intermediate versions. Such a modification would allow the

teachings of Meyer, Stupek and Moser to provide a mechanism that can upgrade a computer program

without requiring that the normal operation of the computer program be suspended (see Moser col. 3,

lines 32-36).

As per Applicant's argument on page 13, that "the combination of Meyer, Stupek and Moser fail to

teach or suggest the subject limitation." Respectfully, Applicant(s) appear(s) to misinterpret the guidance

given under MPEP 2142. In particular, references are evaluated by what they suggest to one versed in

the art, rather than by their specific disclosures, *In re Bozek,* 163 USPQ 545 (CCPA 1969).

There are numerous court decisions supporting the position given above. The issues of

obviousness is not determined by what the references expressly state but what they would reasonably

suggest to one of ordinary skill in the art, as supported by decisions in *In re Delisle 406 Fed 1326, 160 USPQ 806; In re Kell, Terry and Davis 208* USPQ 871; and *In re Fine,* 837 F.2d 1071, 1074, 5 USPQ 2d 1596, 1598 (Fed. Cir. 1988)(citing *In re Ialu,* 747 F.2d 703, 705, 223 USPQ 1257, 1258 (Fed. Cir. 1988)). Further, it was determined in *In re Lamberti et al, 192 USPQ 278 (CCPA) that:*

(I)   obviousness does not require absolute predictability;

(II)   non-preferred embodiments of prior art must also be considered; and

(III)   the question is not express teaching of references, but what they would suggest.

According to *In re Jacoby,* 135 USPQ 317 (CCPA 1962), the skilled artisan is presumed to know something more about the art than only what is disclosed in the applied references. In *In re Bode,* 193 USPQ 12 (CCPA 1977), every reference relies to some extent on knowledge of persons skilled in the art to complement that which is disclosed therein.

MPEP 2111 Claim Interpretation; Broadest Reasonable Interpretation

During patent examination, the pending claims must be "given the broadest reasonable interpretation consistent with the specification" Applicant always has the opportunity to amend the claims during prosecussion and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. In re Prater, 162 USPQ 541,550-51 (CCPA 1969). The court found that applicant was advocating ... the impermissible importation of subject matter from the specification into the claim. See also In re Morris, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997) (The court held that the PTO is not required, in the course of prosecution, to interpret claims in applications in the same manner as a court would interpret claims in an infringement suit. Rather, the "PTO applies to verbiage of the proposed claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definition or otherwise that may be afforded by the written description contained in application's specification.").

The broadest reasonable interpretation of the claims must also be consistent with the interpretation that those skilled in the art would reach. In re Cortright, 165 F.3d 1353, 1359, 49 USPQ2d 1464, 1468 (Fed. Cir. 1999).

Conclusion

3.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

CONTACT INFORMATION

4.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to JEAN B. FLEURANTIN whose telephone number is 571 – 272-4035. The examiner can normally be reached on 7:05 to 4:35.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, JOHN E BREENE can be reached on 571 – 272-4107. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jean Bolte Fleurantin

Patent Examiner

Technology Center 2100

September 01, 2005
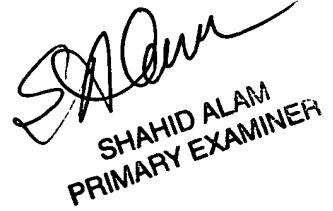
SHAHID ALAM
PRIMARY EXAMINER